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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/697,705

10/29/2003

Emory Hutchins Matts

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8348

43896

7590

02/14/2006

ECOLAB INC.

MAIL STOP ESC-F7, 655 LONE OAK DRIVE

EAGAN, MN 55121

EXAMINER

SMITH, KIMBERLY S

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/697,705	Applicant(s) MATTS ET AL.	
	Examiner Kimberly S. Smith	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-31 and 33-73 is/are pending in the application.
- 4a) Of the above claim(s) 13,15-17,33 and 42-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14 and 18-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/23/05 has been entered.

### ***Election/Restrictions***

2. Applicant's election with traverse of the withdrawal of claims 53-61, 63-65, 67-68 and 70-73 in the reply filed on 11/23/05 is acknowledged. The traversal is on the ground(s) that the invention as originally claimed including the limitations of the withdrawn claims. This is not found persuasive because the newly added claims were directed to a combination of an insect suppression statement in conjunction with a mounting surface having a hole provided thereon. The mounting surface had not previously been presented for prosecution and the Applicant has not specifically pointed out the errors of the restriction requirement between the combination and subcombination. The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

3. Applicant's arguments filed 11/23/05 have been fully considered but they are not persuasive. With respect to the rejection under 35 U.S.C. § 112 Second Paragraph. It is maintained that the claims as presented do not provide a clear indication as to which claims

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require the suppression station and which claims add in the requirement of the suppression device as well. As the Applicant has stated that the independent claim is directed solely to the station and does not require the insect suppression device, the claims have been construed as only the suppression station. It is noted that the claims never positively recite an insect suppression device and as such, the use of an insect suppression device and the claims directed thereto are considered to be intended use recitations, in that the prior art merely needs to be capable of being used in such a manner.

4. With respect to the argument regarding Johnson et al. (US 3,807,768) not teaching the underside of the lid being capable of receiving an insect suppression device, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Insect suppression devices are various in their design and structure and it is maintained that the cover of Johnson is capable of receiving an insect suppression device such as an adhesive insect suppression tape.

5. With respect to the arguments regarding Claim 29 in that Johnson’s device discloses feet and not a frustoconical surface as claimed by the Applicant. The Applicant has not pointed out the Examiner’s error in reading the feet of Johnson as frustoconical, only that the intended use is different. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As insects are capable of using Johnson’s device, the claimed limitations are met by Johnson.

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6. With respect to the Applicant's arguments regarding Dunston et al., US 6,796,082 not being capable of mounting onto a vertical surface. This is respectfully disagreed with. While Dunston is directed to a device which is designed to be inserted into the ground, such a limitation does not limit the ability for the station to be mountable onto a vertical surface as the device is capable of being mounted within a hillside or landscaped ledge providing a vertical surface.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12, 14, 18-31, 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1-12, 14, 18-31, 34-41, the independent claims are directed to an insect suppression station for baiting with insect suppression devices. As such, it is unclear as to whether the Applicant is claiming the suppression station or the combination of the suppression station and the suppression devices as the suppression devices have not been positively claimed outside of a functional recitation. As per the Applicant's statement that claim 1 is directed solely to the suppression station, Claims 1-12, 14, 18-31, 34-41 have been construed for the basis of art rejection as the subcombination of the suppression station.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3, 4, 5, 11, 12, 14, 18-21, 24, 25, 29, 30, 34-40 are rejected under 35

U.S.C. 102(e) as being anticipated by Johnson et al., US Patent 6,807,768 B2 (Johnson).

Johnson discloses a base (22) that is mountable on a vertical surface (as there is no structure precluding the mounting of the device on a vertical structure) having a first area and a cover (24) including an overhang portion that extends beyond the base (as viewed in Figure 3) having a second area (i.e. that located on the underside of the cover) wherein the second area is positioned to be spaced from and partially overlapping the first area and the station encloses the first and second areas on at least two sides (as viewed in Figure 1) and wherein the cover after attached to the base is movable.

Regarding claim 3, Johnson discloses the base is configured to conform to a planar mounting surface at an outside edge of a back surface (i.e. 72).

Regarding claim 5, Johnson discloses the station defining two or more insect entry areas (at 32).

Regarding claims 11, 12, 14, 34 and 35, the Johnson device is capable of use with an insect attractant including polystyrene or a pheromone and as such, the claimed limitations are met. As the insect suppression device has not been structurally claimed and has been disclosed

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in a functional recitation, it has been held that the recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masha*, 2 USPQ2d 1647 (1987)

Regarding claims 18-20 and 36-38, Johnson discloses the invention is made from a water resistant, impact resistant material, i.e. plastic.

Regarding claims 21 and 39, Johnson discloses the station including an outer domed portion (as viewed in Figure 3).

Regarding claim 24, Johnson discloses the station includes a back side (i.e. bottom surface of (74)) and a widest portion (28) spaced from the back side (as viewed in Figure 3) wherein the perimeter of the back side and the widest portion are both substantially circular (as viewed in Figure 4), wherein the outer diameter of the back side is less than the outer diameter of the widest portion.

Regarding claim 25, Johnson discloses the cover is configured to be removed from the base.

Regarding claim 29, Johnson discloses an insect station having a fist area (28), a cover (24) and a back side for mounting comprising a mounting structure (72), wherein the station defines a cutaway portion (74) adjacent the back surface to deflect water running down the planar surface (column 4, lines 25-26).

Regarding claims 4 and 30, Johnson discloses guide walls (64).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al., US Patent 6,807,768 B2 (Johnson).

Regarding claim 22, Johnson discloses the device substantially as claimed. However, Johnson only discloses a single mounting hole, not “holes”. It would have been an obvious matter of design choice to use more than one hole, since it has been held that the mere duplication of an essential working part of a device involves only routine skill in the art.

Regarding claim 23, Johnson discloses the invention substantially as claimed. However, Johnson does not positively disclose the type of mounting device used. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a fastener such as a nail or a screw to adhere the base since the examiner takes Official Notice that screws and nails are notoriously well known in the art for extending through structures to fix a device in place.

14. Claims 26-28 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al., US Patent 6,807,768 (Johnson) as applied to claims 25 and 29 above respectively, and further in view of Pleasants, US Patent 6,272,791.

Johnson discloses the invention substantially as claimed. However, Johnson discloses a station having a rotatable connection between the base and cover. Pleasants teaches within the

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same field of endeavor that a rotatable cover (i.e. 130) is a structurally equivalent device as a deformable cover (i.e. 30) having a rim which engages attachment tabs and is deformed to bring the tabs out of engagement with the rim. Therefore, because these two cover/base attachment mechanism were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a rotatable cover for a deformable cover.

15. Claims 1 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest et al., US Patent 4,841,669 (Demarest) in view of Snell et al., US Patent 6,378,243 (Snell).

Demarest discloses a base that is mountable to a vertical mounting surface (as there is no structure preventing such mounting), a cover, a first and second area for receiving an insect suppression device (as viewed in Figures 1 and 2), wherein the second area includes a structure configured to retain a first or second insect suppression device (reference discussion above under Response to Arguments) wherein the station encloses the first and second areas at least on two sides (via ridges 18). However, Demarest does not disclose an overhang portion that extends beyond the base. Snell teaches within the same field of endeavor the use of a cover having an overhanging portion so as to reduce ingress of excess rain or other surface water (column 21, lines 23-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the overhanging cover as taught by Snell with the device of Demarest in order to reduce the amount of rain and other surface water that may enter the device.

Regarding claim 6, Demarest discloses the first area including a recessed area (seen in Figure 2) for receiving the insect suppression device and tabs (26) for retaining the device.

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Regarding claims 7 and 9, the vacant area defined in Demarest by (18) and (20) is deemed a depression adjacent the first and second areas which facilitates the placement and removal of the suppression device.

Regarding claim 8, Demarest discloses the second area including a recessed area (seen in Figure 2) for receiving the insect suppression device and tabs (26) for retaining the device.

Regarding claim 10, Demarest discloses the first and second areas are the same shape and size.

16. Claims 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demarest et al., US Patent 4,841,669 (Demarest) in view Snell, et al., US Patent 6,378,243 (Snell) in view of Johnson et al., US Patent 6,807,768 (Johnson).

Demarest discloses a cover, a first and second area for receiving an insect suppression device (as viewed in Figures 1 and 2), wherein the second area includes a structure configured to retain a first or second insect suppression device (reference discussion above under Response to Arguments) wherein the station encloses the first and second areas at least on to sides (via ridges 18). However, Demarest does not disclose an overhang portion that extends beyond the base. Snell teaches within the same field of endeavor the use of a cover having an overhanging portion so as to reduce ingress of excess rain or other surface water (column 21, lines 23-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the overhanging cover as taught by Snell with the device of Demarest in order to reduce the amount of rain and other surface water that may enter the device. Demarest also does not disclose the use of a cutaway portion adjacent to the back surface. Johnson teaches within the same field of endeavor the use of a cutaway portion (74) so as to reduce the introduction of water

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into the station (column 4, lines 25-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the cutaway portion as taught by Johnson with the device of Demarest in order to reduce the introduction of water into the station.

Regarding claim 31, Demarest as modified discloses a first recessed area for receiving a suppression device (as viewed in Figure 2) and tabs (26) for retaining the device.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kimberly S Smith  
Examiner  
Art Unit 3644